

AMENDMENTS TO THE DRAWINGS

The drawings are amended to overcome the objection under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Please replace sheet 11 of the drawings depicting FIGS. 13-15B with the enclosed proposed sheet 11 of the drawings including amended FIG. 14.

Attachment:

- One Replacement Sheet; and
- One Annotated Sheet.

REMARKS

The undersigned attorney thanks Examiner Kavanaugh for his time and courtesy extended during the telephonic interview with him on September 20, 2005. Applicant appreciates the helpful comments made by the Examiner and hereby amends FIG. 14 consistent with the discussions during the interview.

Before entry of this Amendment and Response, the status of the application according to the pending Office action is as follows:

- The drawings are objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims.
- Claims 22 and 24 are withdrawn.
- Claims 1-5, 9-21, 23, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,535,553 to Derderian et al. (hereinafter "Derderian").
- Claims 1-3, 15, 18, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,498,251 to Shin (hereinafter "Shin").
- Claims 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Derderian.
- Claims 25-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shin in view of U.S. Patent No. 5,367,792 to Richard et al. (hereinafter "Richard").
- Claims 29-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Applicants hereby amend claims 1, 3, 8-11, 16, and 34, without prejudice, cancel claims 2 and 15, and add new claims 35-38, as shown in the preceding Listing of Claims. Support for new independent claim 35 can be found at least in paragraph [0057]. Support for new dependent

claims 36 and 37 can be found at least in paragraph [0048] and the disclosure of U.S. Patent No. 6,722,058, as incorporated by reference therein (see, for example, FIG. 5 and column 5, lines 44-51). Claim 38 is objected to claim 29 and intervening claim 25 rewritten in independent form. Independent claims 1 and 34 are amended to include the subject matter of now cancelled dependent claims 2 and 15, as originally filed. Dependent claims 3, 8-11, and 16 are amended to update claim dependency. No new matter has been added thereby. Upon entry of this Amendment and Response, claims 1, 3-14, 16-21, 23, and 25-38 will be pending, with claims 22 and 24 withdrawn from consideration.

In view of the above amendments and following remarks, Applicants respectfully request reconsideration and withdrawal of all grounds of rejection and objection and passage of claims 1, 3-14, 16-21, 23, and 25-38 to allowance in due course.

1. The drawings are objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Applicants have amended FIG. 14 as shown in the attached Replacement Sheet to clearly indicate the varying wall thickness, as recited in claim 28. Paragraph [0055] of the specification, as filed, has been amended to be consistent with amended FIG. 14.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to the drawings under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims.

2. Claims 1-5, 9-21, 23, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Derderian. Applicants have cancelled claims 2 and 15, thereby rendering moot the rejection with respect to those claims. Applicants respectfully traverse this rejection as applied to the remaining claims, as amended.

Briefly, Derderian appears to disclose an athletic shoe 10 having an upper 12 and a sole 16, wherein the sole 16 includes an outer sole 18 and a midsole 20. The midsole 20 comprises an insert member 22 encased in resilient foam material 24, where the insert member 22 is made up of a plurality of elongate base members 26 with a plurality of elongate flexible legs 32 connected to the base element 26 and joined at their convergent ends by a connecting element 42 (See Derderian, column 5, line 60 to column 6, line 22).

Applicants' amended independent claims 1 and 34 include a sole for an article of footwear comprising "*a first area including a first deformation element comprising a foamed material; and a second area including a second deformation element comprising an open-walled structure free from foamed materials.*" Applicants respectfully submit that Derderian fails to teach or suggest such a structure, but rather appears to teach a sole layer that is comprised of "*an insert member 22 encased in a resilient foam material 24*" (column 6, lines 5-6), which covers the entire sole region of the shoe (see FIGS. 1 and 2). The insert members of Derderian are, therefore, not in a second area free from foamed materials.

Applicants' amended independent claims 1 and 34 further recite a second deformation element that includes "*at least two side walls and at least one tension element interconnecting center regions of the side walls.*" Applicants respectfully submit that Derderian fails to teach or suggest such a structure, but rather appears to teach an insert member that is constructed from a "*plurality of elongate flexible legs*" (column 6, line 28). These legs are connected at one end to a base member 26 and at their convergent ends by a cap 42. As such, the legs are not connected by a tension element that interconnects at their center regions.

Thus, Derderian does not teach or suggest a sole for an article of footwear comprising "*a first area including a first deformation element comprising a foamed material; and a second*

area including a second deformation element comprising an open-walled structure free from foamed materials,” with a second deformation element that includes “at least two side walls and at least one tension element interconnecting center regions of the side walls,” as recited in Applicants’ independent claims 1 and 34. Because claims 1, 3-5, 9-14, 16-21, and 23 depend, either directly or indirectly, from independent claim 1, and include all of the limitations thereof, Applicants respectfully submit that these claims are allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 3-5, 9-14, 16-21, 23, and 34 under 35 U.S.C. §102(b) based on Derderian.

3. Claims 1-3, 15, 18, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shin. Applicants have cancelled claims 2 and 15, thereby rendering moot the rejection with respect to those claims. Applicants respectfully traverse this rejection as applied to the remaining claims, as amended.

Briefly, Shin appears to disclose a shoe including an outsole 30 and a midsole that includes foam material sections 32, 34, and 36. The outsole 30 is made from solid rubber and includes a ball section 44 that includes transverse slots 50 that extend to the lower surface 48 of the outsole and extend upwardly so as to terminate just short of the upper surface of the ball section 44. A number of struts 54 bridge the upper part of each slot 50 to prevent the outsole material from splitting above the slots 50, while being sufficiently flexible so as not to appreciably interfere with the bending or flexing at the ball area of the outsole 30 (see Shin, column 2, line 48, to column 3, line 32).

Applicants’ amended independent claims 1 and 34 recite a second deformation element that includes “at least two side walls and at least one tension element interconnecting the side walls,” wherein “*the tension element interconnects center regions of the side walls.*”

Applicants respectfully submit that Shin fails to teach or suggest such a structure, but rather appears to teach an outsole that includes a number of struts that are located “*at the upper part of each slot,*” where the struts are designed to prevent the material above the slots from splitting, and do not “*appreciably interfere with the bending or flexing at the ball area*” of the outsole. As such, the struts disclosed by Shin are not tensioning elements and do not interconnect center regions of the side walls.

Thus, Shin does not teach or suggest a sole for an article of footwear comprising a second deformation element that includes “*at least two side walls and at least one tension element interconnecting center regions of the side walls,*” as recited in Applicants’ independent claims 1 and 34. Because claims 3 and 18 depend directly from independent claim 1, and include all of the limitations thereof, Applicants respectfully submit that these claims are allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 3, 18, and 34 under 35 U.S.C. §102(b) based on Shin.

4. Claims 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Derderian. Applicants respectfully traverse this rejection as applied to the claims, as amended.

As described above, Derderian does not teach, suggest, or motivate one skilled in the art to arrive at a sole for an article of footwear comprising “*a first area including a first deformation element comprising a foamed material; and a second area including a second deformation element comprising an open-walled structure free from foamed materials,*” where the second deformation element includes “*at least two side walls and at least one tension element interconnecting center regions of the side walls,*” as recited in Applicants’ independent claim 1.

Applicants, therefore, submit that Derderian fails to provide the teaching, suggestion, or motivation for one skilled in the art to arrive at Applicants’ invention, as recited in independent

claim 1. Because claims 6-8 depend indirectly from independent claim 1, and include all of the limitations thereof, Applicants respectfully submit that claims 6-8 are allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Derderian.

5. Claims 25-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shin in view of Richard. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Richard appears to describe a shoe sole including an outer sole 14 and an intermediate layer 12, wherein the outer sole 14 may be a separate layer or be integral with the intermediate layer 12, and the intermediate layer 12 is disposed between the outer sole 14 and an upper 8 (column 3, lines 22-37). The intermediate layer 12 is constructed as a hollow shell 28 surrounding a chamber 30 containing air, foam 32, or other material. The periphery of the intermediate layer 12 includes convolutions 22 that extend horizontally from the upper surface to the lower surface of the intermediate layer 12, wherein the convolutions create a bellows-like structure allowing intermediate layer 12 to compress in an accordion-like fashion when force is applied to the upper or lower surface. (See Richard, column 3, line 6 to column 5, line 30).

Applicants respectfully submit that the disclosure of Richard fails to cure the deficiencies of Shin with respect to independent claim 1, as outlined in section 3 above. Specifically, Richard fails to teach, suggest, or motivate one skilled in the art to arrive at a second deformation element that includes “*at least two side walls and at least one tension element interconnecting center regions of the side walls.*”

Applicants, therefore, submit that neither Shin nor Richard, alone or in proper combination, provides the teaching, suggestion, or motivation for one skilled in the art to arrive

at Applicants' invention, as recited in independent claim 1. Because claims 25-28 depend, either directly or indirectly, from independent claim 1, and include all of the limitations thereof, Applicants respectfully submit that claims 25-28 are allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 25-28 under 35 U.S.C. § 103(a) as being unpatentable over Shin in view of Richard.

6. Claims 29-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants appreciate the Examiner's indication of the allowability of claims 29-33. Applicants respectfully submit that claims 29-33 are patentable, because claims 29-33 depend indirectly from amended independent claim 1, which is patentable for the reasons discussed hereinabove. Without acquiescing to the objection, however, Applicants have rewritten claim 29 as new claim 38, incorporating the subject matter of independent claim 1 and intervening claim 25.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to claims 29-33, as being dependent upon a rejected base claim.

7. With this Amendment and Response, Applicants hereby add new claims 35-37. Claims 35-37 are patentable at least because the cited art does not teach or suggest a sole including an outsole and a load distribution plate, wherein "*the first and second deformation elements are arranged between the outsole and the load distribution plate,*" as recited in independent claim 35, and from which claims 36 and 37 depend.



Accordingly, Applicants respectfully request allowance of new claims 35-37 in due course.

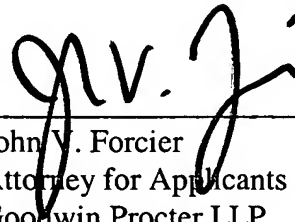
CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection and objection, and allowance of claims 1, 3-14, 16-21, 23, and 25-38 in due course.

Additionally, Applicants respectfully request reentry and allowance of withdrawn claims 22 and 24, as these claims depend, either directly or indirectly, from independent claim 1, which is patentable for the reasons discussed hereinabove.

The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,



John V. Forcier  
Attorney for Applicants  
Goodwin Procter LLP  
Exchange Place  
Boston, Massachusetts 02109

Date: September 28, 2005  
Reg. No. 42,545

Customer No. 051414  
Tel. No.: (617) 570-1607  
Fax No.: (617) 523-1231

LIBA/1584489.1

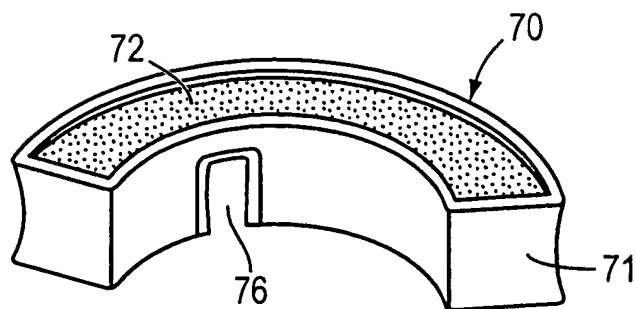


FIG. 13

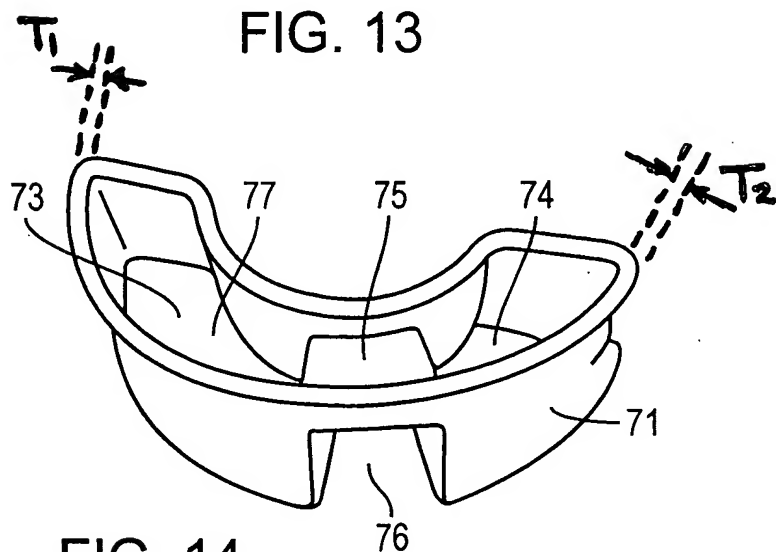


FIG. 14

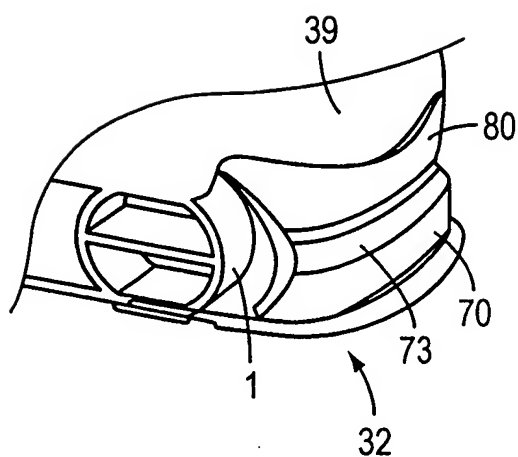


FIG. 15A

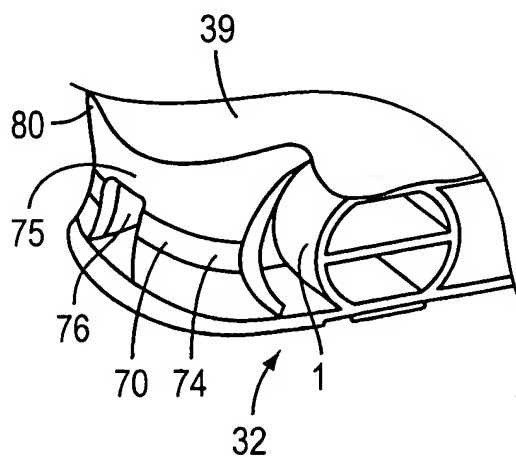


FIG. 15B